



CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this paper (along with any paper referenced as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 25, 2004

Jonathan A. Platt

Attorney Docket No. ERICP0328USA

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Applicants: Gregel et al.

Serial No.: 10/081,376

Filed: February 21, 2002

Title: REINFORCING BAR CONNECTION AND METHOD

Examiner: Winnie S. Yip

Art Unit: 3637

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

The Examiner's Answer necessitates the following remarks in reply.

Related Appeals and Interferences

The Examiner's Answer states that the Appeal Brief "does not contain a statement identifying the related appeals and interferences." Answer, page 2. This is in error, since the Appeal Brief contained the unambiguous statement, "There are no related appeals or interferences," under the unambiguous heading, "RELATED APPEALS AND INTERFERENCES." Appeal Brief, page 1.

Status of the Claims

With entry of the amendment accompanying the Appeal Brief, Applicants are in agreement with the Examiner that the listing of the appealed claims in Appendix A of the Appeal Brief is correct, and that the listing in Appendix B should be withdrawn.

Grouping of the Claims

The Appeal Brief included a proposed grouping of claims, and detailed separate arguments for the patentability of certain individual claims. See Appeal Brief, pages 6 and 10-13. Thus it was clear that the intent was that not all of the claims of each issue stood or fell together. Nevertheless, due to the failure to include certain "magic words" in the Appeal Brief, the Examiner has chosen to treat all the claims of each issue as standing or falling together.¹ Answer, page 3. This is contrary to accepted USPTO procedure in such a situation. See MPEP 1206 ("Where ... the appellant ... omits the statement required in 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief ... the appellant should be notified of noncompliance.") Failure to follow this procedure has placed Applicants in the unenviable position of either accepting the Examiner's error, or of petitioning for a determination that the Appeal Brief be declared noncompliant. See *Ex parte Ohsumi*, 21 USPQ2d 1020, 1023 (Bd. App. 1991). Rather than incur the delay and expense of a petition, Applicants have elected to proceed with the appeal.

Prior Art Rejections

Applicant's position with regard to claim 1 may be summarized as follows: Schade's crimped or pressed socket is a totally different type of connector than that recited in the claims, and there would be no motivation to use Dobell's pronged plates

¹This requirement, previously located in 37 CFR 1.192(c)(7), has recently been eliminated.

in Schade's socket, since to do so would provide no advantage, and because the crimping of Schade's socket would destroy the integrity of Dobell's pronged plates, rendering them useless for their intended purpose. The Examiner answers this by incredibly disputing that the crimping of Schade's thick-walled socket onto rebar would disturb the integrity of Dobell's pronged plates if the latter were placed between the socket and the rebar.² From here she concludes that, even after crimping, Dobell's pronged plates would allow "biting and gripping [of] the reinforcing bar while maintaining sufficient resiliency so as to distribute the load between the plurality of washers."³ However, this premise is faulty, so the conclusion is as well, and there is no motivation for the proposed combination.

Schade makes mention again and again of the use of hard material adjoining the rebar: the prior art teaches use of "a socket with interior ribs that [are] harder than the rebar"; the prior art also teaches sprinkling "hard granulate between the rebar and the socket prior to the pressing" of the socket; and Schade's invention itself involves insertion of "hardened metal rings" between the rebar and the socket. See Schade, page 1, lines 22-28; page 2, lines 8-12 and 30-32.⁴ There is no indication in Dobell that Dobell's pronged plates 35 utilize a hardened material – they are described only as "metal plates," col. 4, line 51. Rather, numerous characterizations of Dobell's pronged plates 35 make it clear that they are anything but hardened: the prongs 37 of the plates 35 are "flexible," are "not too heavily constructed," and have "resiliency," col. 4, line 59

²"The Examiner respectfully disagrees with Appellant's argument that the 'crimping' or 'pressing' of [Schade's] sleeve would destroy the integrity of [Dobell's] pronged plates." Answer, page 11.

³Answer, page 5. In support of this proposition the Answer cites "Schade et al. [sic] col. 4, lines 53-59." It appears that the citation should have been to Dobell, rather than Schade.

⁴All of the quotations from Schade used herein are from the English translation of Schade appended to the Appeal Brief as Appendix C.

and col. 6, lines 57-58; the plates themselves have rims that are flattened as a cap 38 is screwed down on a stack of plates 35 and washers 36, col. 6, lines 69-74. Dobell's pronged plates 35 are not hardened and would not have their desired characteristics if they were hardened. Due to the configuration and flexible characteristics of Dobell's pronged plates 35, they would clearly be crushed if placed in Schade's crimped socket. What else would one expect from placing flexible metal plates between a socket and rebar ends, and then pressing in on the socket so hard that it permanently deforms around the rebar? Since the proposed combination would destroy the integrity and usefulness of Dobell's pronged plates, there is no motivation for the proposed combination, and claim 1 is thus patentable over Schade and Dobell.

The Appeal Brief, at page 11, points out several shortcomings to the proposed addition of a tertiary reference, Lande, for the teaching of certain features of dependent claims. For example, it is observed that there would be no reason to add Lande's grooves to Schade's press-on socket, since the grooves would be crushed in the crimping process, and might hinder sliding of rebar (with the hardened rings) into Schade's socket. Also, at page 11 there is a discussion of the impracticality of adding resin, per Lande, to Schade's socket, either before or after the pressing of the socket. There is no response to these points whatsoever in the Examiner's Answer, save perhaps for the naked assertion on page 13 that "it would have been obvious" to introduce a resin into Schade's socket, already modified by the introduction of Dobell's pronged plates. Applicant's points on this issue remain uncontroverted.

This reply is submitted in triplicate.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By



Jonathan A. Platt
Reg. No. 41,255

1621 Euclid Avenue, 19th Floor
Cleveland, Ohio 44115-2191
(216) 621-1113